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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/941,174
Filing Date: September 30, 1997
Appellant(s): BRUSKY ET AL.

MAILED

JUL 13 2006

Technology Center 2600

N. Rhys Merrett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/20/2004 appealing from the Office action
mailed 7/20/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,191,423	YOSHIDA	3-1993
6,049,796	SIITONEN	4-2000

Gateway 2000, "Destination Features", Press Release, 08/21/1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 8-12 & 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gateway 2000 (Press Release, 08/21/1996), in view of Yoshida, (U.S. Pat # 5,191,423), in view of Siitonen, (U.S. Pat # 6,049,796).

Considering claim 8, Gateway 2000 meets the claimed PCTV computer system having a keyboard for providing alphanumeric characters to the PCTV computer and also a display monitor, pg. 3. Gateway 2000 discloses that the PCTV includes a keyboard and the TV display screen, pg. 4. The PCTV system also enables the user to place the system in one of a PC or TV mode; see pg. 2. The disclosure of the Destination Big Screen PCTV allows for watching TV in

a full-size screen mode or as a resizable window in a PC desktop environment, which meets the newly claimed feature of TV mode and a computer mode with an active window.

The claimed feature of storing predetermined Internet site names is met by the disclosure, which teaches on pg. 1, that in the Destination Software Collection, at least Microsoft Works 95 may be pre-installed on the PCTV. The use of Microsoft Works 95 requires at least the Windows 95 operating system, which includes the Microsoft's Internet Explorer. Microsoft's Internet Explorer is a web browsing software package and it at least includes the URL to the Microsoft web site, which reads on the claimed storing predetermined Internet site names.

Furthermore, the Destination Software Collection that comes with the PCTV of Gateway 2000, also includes Trials for on-line services and Internet access, which necessarily include web sites addresses, at least of the on-line services; see pg. 2. Thus the Gateway 2000 provides at least two ways of storing pre-determined Internet site names, and reads on the claimed subject matter.

As for the additionally claimed feature of storing predetermined station names, the recitation reads on at least temporarily storing an EPG at the PCTV. Gateway 2000 discloses on pg. 3 that a user may choose the option for an on-line TV service. By ordering the on-line TV guide service, the user may scroll through up to two weeks of programming. Even though it is not explicitly disclosed that this on-line TV guide data may be stored at the PCTV, Official Notice is taken that storing EPG data at a consumer network equipment, such as a set-top box was very well known in the art at the time invention was made. It would have been obvious for

one of ordinary skill in the art at the time the invention was made, to operate Gateway 2000 in a manner wherein the EPG data is at least temporarily stored at the PCTV, at least in order to speed up the user's access to the EPG data since the data is stored locally instead of being retrieved from the network each time the user desires to view the data.

Regarding the additional claimed feature of the alphanumeric keyboard containing a key with an associated channel macro for selecting a predetermined network or Internet site name, Gateway 2000 does not explicitly disclose such a feature, even though the reference does discloses that the subscriber may browse through the TV guide according to station call signs, see page 3. Nevertheless, TV tuning systems were well known in the art at the time the invention was made which enabled a user to select a predetermined station by inputting its corresponding station name via alphanumeric keys on a user controlled station selection device.

Yoshida provides such a user controlled station selection device 40, Fig. 2. In particular, Yoshida teaches that the user selects a station by pressing the corresponding alphanumeric keys on the channel selection device 40, (col. 1, lines 55-67). Yoshida furthermore provides that the user merely needs to input the first letter of the desired station name, and subsequently the list of all stations with the corresponding first letter is displayed on the TV screen for the user to select from, (col. 1, lines 60-67; col. 4, lines 10-22). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Gateway 2000 with the known feature of a user inputting an alphanumeric representation of a station in order to select the instant station as shown by Yoshida, at least for the known desirable

benefit of avoiding the user memorizing the entire name of a desired TV station, as taught by Yoshida.

Regarding the amended claimed feature of effecting a second actuation of the same or another alphanumeric key and creating a display of the or each stored station name or Internet site name containing an initial sequence of characters matching the sequence of characters associated with the sequence of alphanumeric key actuations, Yoshida only teaches entering the first alphanumeric key actuation. Nevertheless, one of ordinary skill in the art would have been motivated to sort a list of stations using more than just the first alphabet, at least in order to provide the user with a narrower search.

It is taught by Siitonen, that when a user wants to search for a particular item in a database, for the user to enter the first few letters of the names. As the user enters the name of item, by entering multiple letters, the system automatically searches the database and provides a list of items that match the sequence of alphabets entered by the user; see col. 2, lines 51-64 & col. 9, lines 45-62. It would have been obvious for one of ordinary skill in the art, at the time the invention was made to modify the combination of Gateway 2000 and Yoshida, with well known feature of alphabetically sorting items using more than the first letter, as taught by Siitonen, col. 2, lines 51-54, for the improvement of providing the user with opportunity to refine a search.

Considering claim 5, Gateway 2000 discloses a wireless keyboard, pg. 4.

Considering claim 9, the claimed step of downloading an EPG from a network provider reads on the discussion in Gateway 2000 of the electronic TV guide subscription.

Regarding claims 10 & 12, Official Notice is taken that highlighting and channel banners of a user selectable item were notoriously well known in the art of TV graphical user interface technology, at the time the invention was made. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Gateway 2000 in a manner wherein channel banners or highlighting of channels is used, at least for the well-known benefit of insuring that the user is informed of which channel has been selected.

Regarding claim 11, Gateway 2000 teaches a user watching TV, even while in computer mode; see pg. 2.

Considering claims 17-18 & 21-22, Gateway 2000 teaches using the wireless keyboard or Field Mouse remote control for operation of the TV; see pg. 4.

Considering claims 19 & 23, Gateway 2000 discloses that the PCTV has full screen TV mode, and a video window while in PC mode.

Considering claim 20, the claimed features of a computer system emulating a TV system, which corresponds with subject matter of claim 8, are likewise analyzed. As for the additionally claimed feature of channel macros operably associated predetermined TV networks, the feature

reads on each letter being input in Yoshida, which generates a different list of broadcast stations. The channel macros operably associated with an Internet network site, reads on the URL's listed in Siitonen when the user inputs the letters that represent the Internet site names.

Considering claim 24, the claimed method steps of the PCTV corresponds with subject matter mentioned above in the rejection of claims 8 & 20, and is likewise rejected. As for the additionally claimed feature of marking the identifier, Official notice is taken that at the time the invention was made; highlighting an item was a well-known GUI function. It would have been obvious for one of ordinary skill in the art at the time the invention was made to operate the combination of Gateway 2000, in view of Yoshida & Siitonen, with the technique of enabling a user to highlight an item on a list, at least for the desirable benefit of allowing the user to be sure that the correct item is selected before the selection is executed.

(10) Response to Argument

Appellant begins arguments on page 6 with the argument (which is repeated on page 17) that since during the examination process a particular reference may have been replaced with another reference, that such a procedure represents evidence of impermissible hindsight. Examiner respectfully disagrees and finds no correlation with the two issues. Appellant also suggests on page 7 (and again on page 18) that the base reference appears to be published as a

promotional or marketing material, which cannot be relied upon, because its “technical accuracy may be imprecise”. Again examiner respectfully disagrees with this assertion since the disclosure uses specific terms that have established meaning in the computer and/or television systems art. It is noted that appellant has not cited any particular feature disclosed in the material that “does not have credibility” and that are “factually unsupported claims of functional capability”, as argued.

Appellant next argument found on pages 8 & 9, that “neither Gateway nor Yoshida discloses or suggests, …effecting a first actuation of an alphanumeric key on said keyboard; creating a monitor display of the or each station name… effecting a second actuation of the same or another alphanumeric key on said keyboard; creating a monitor display of the or each stored network station name or internet site name containing first and second characters matching the characters associated with said first and second alphanumeric key…” (with respect to claims 8 & 24). Examiner points out that this argument is moot since examiner relies upon the Gateway reference, in view of Yoshida & Siitonens to teach the claimed subject matter.

Likewise on page 9, appellant argues with respect to claim 20 that, “Nor does Gateway or Yoshida disclose or suggest: …the combination of said computer, said monitor and said alphanumeric keypad providing a visual listing of networks by depicting on said monitor successive lists of network names, each list containing network names including an initial sequence of a plurality of characters matching the sequence of characters associated with a sequence of alphanumeric key entry actuation as they are entered by the user, until the user

enters a select input to establish combination with the selected network". Again, examiner points out that this argument is moot since Siitonen is relied upon to teach entering plurality of characters and displaying the sequence of names, such that the initial letter of the names match the sequence of characters entered by the user, see Fig. 7B; col. 2, lines 55-65; col. 9, lines 52-65 thru col. 10, lines 1-20.

Appellant also argues on page 9 that, "Nor is there a suggestion of a key on the computer system keyboard 'to tune to a network station', as recited in claims 17 & 21, which depend from claims 8 & 20, respectively. Again examiner points out that rejection is made with the combination of Gateway, Yoshida & Siitonen. The combination of the keypad device in Yoshida with the wireless keyboard in Gateway 2000, reads on the claimed subject matter.

With respect the claimed, "keyboard for providing alphanumeric characters to said PC/TV", appellant argues that the claimed feature is not met by the combination of Gateway 2000, in view of Yoshida. Examiner respectfully disagrees and first of all points out that Gateway 2000 disclosure on page 4 of, 'with one click, takes you to television', clearly means television mode. Furthermore, appellant argues on page 11, that "In particular, Yoshida's telephone-type keypad 40 does not equate to or suggest operation of a ... keyboard for providing alphanumeric characters...". However, examiner points out that the keypad 4 in Yoshida does in fact provide input for "alphanumeric characters", see Fig. , which is used to control the microcomputer system. Thus, examiner respectfully disagrees with appellant's assertion on page 11, that "Consequently, on an interpretation most favorable to the examiner, Yoshida would most

hypothetically have suggested modification of the Gateway 2000 Field Mouse remote", since one of ordinary skill in the art would have readily recognized the benefit of using either device type for television operation.

Furthermore, examiner notes that appellant's specification on page 10, lines 17-24, discloses, "The convergence system 100 may be operable with an input device 110. The input device 110 may comprise any one of the following: a remote control, a standard TV remote control, a remote track-ball/mouse device, a remote pointing device, a wireless keyboard, a wired keyboard, a keyboard integrated with a pointing device or a standard remote control, et cetera". Thus, the invention alternatively supports any one of the well-known input devices, which are clearly discussed by the Gateway 2000 and Yoshida references. It is pointed out that as such, the particular alternative input device is recognized as not essential to the invention, since all of these input devices contain similar input mechanisms that will operate the invention.

With respect to Siitonen, appellant's main argument on page 13 appears to be that, "examiner has arbitrarily selected a single feature from Siitonen (search engine) removed it from the environment of Siitonen and attempted to apply it per se in the very dissimilar relatively simple environment of Yoshida (ignoring the attendant processing and memory capabilities that would be required)". First of all, examiner respectfully disagrees with appellant's characterization of the rejection. The grounds of rejection are Gateway 2000, in view of Yoshida & Siitonen. Therefore the modification is not of Yoshida, but of Gateway 2000, in view of Yoshida. It is pointed out that Gateway 2000 teaches on page 3, "Browse: Functions as a TV

guide database, sorting program information by actor, station call sign, rating title and type.”

Thus the base reference teaches sorting and accessing programs by station name, (as recited in the claims), which implies or suggests an alphabetical sorting algorithm, but doesn't explicitly state as such. However, clearly one of ordinary skill in the art at the time the invention was made, would have been motivated to operate Gateway 2000 by searching the database of station names by presenting the list of stations to the user that have the same first character as the character entered, as taught by Yoshida, which obviates the user from physically viewing each station name in the database to make the selection of the desired station.

Secondly, since it is Gateway 2000, in view of Yoshida being modified, appellant's argument that the memory and processing power of Yoshida does not lend itself to being modified by Siitonen is a moot point, since clearly the PCTV of Gateway 2000 has the capabilities to support the technology of Siitonen. In particular, the publication on page 1 discloses that the PCTV includes an Intel Pentium processor and memory to store and operate at least 15 software applications.

Likewise appellant's argument that “any such hypothetical modification of Yoshida would have required a more sophisticated processor (rather than Yoshida's disclosed microcomputer), and memory sufficient to accommodate data and search engine (application program –Siitonen col. 2, lines 32)”, is also moot since as discussed above, the PCTV of Gateway 2000 is clearly enabled to support such features, in fact as pointed above, Gateway

2000 discloses searching the EPG database, including the station call signs. Therefore, the TV channel searching is already included in the base reference, and appellant's argument is moot.

On page 13, appellant also asserts that, "examiner proposed motivation for combining the teachings of Yoshida and Siitonan also assumes a benefit which is completely speculative on the part of the examiner and is not specifically suggested by either of the applied references".

Again, examiner respectfully disagrees with this assertion and points out that Siitonan clearly teaches in col. 2, lines 157-20, "...utilizing a search criteria and displaying the result so that the user can determine whether the search yielded the intended result, [or] whether the search needs to be refined,". Siitonan goes on to discuss in col. 2, lines 51-65, that "the user can refine the search by adding additional search criteria until finally producing for viewing a minimum number of database records matching the search criteria. For example, if the user types the letter "j" all records having the letter "j" appear." (It is pointed out that this step directly corresponds with the teaching of Yoshida). "The user may continue to type additional letters defining a name, for example, the pair of letters "on" chooses records such as "Jones", but not records such as "Jackson"...".

Therefore the motivation provided by Siitonan of allowing the user to refine the search is very clear and does not represent improper hindsight for modifying Gateway 2000, in view of Yoshida, as asserted by the appellant. Examiner notes that the technique of searching a database of items according to alphabetical order is a well-established function and was not a patentably distinct feature at the time the invention was made. For instance, when organizing books in a

library, items in a catalogue or even names in a list, the technique of organizing/searching records according to the alphabet and increasing a search speed by eliminating from the search the items whose identification do not fit the alphabetical characters entered in the search was well established.

Furthermore the claim that searching network station ID using an alphabetical algorithm was novel at the time of the invention, is not supported by the disclosure of Yoshida, which clearly teaches such a technique. However, as pointed out in the rejection, Yoshida merely discusses using the first alphabet, whereas Siitonen teaches searching records using multiple characters. Examiner thus responds to appellant's argument on page 15, that "Yoshida is emphatic that his teaching of display of station names having an initial letter corresponding to that selected by a user is adequate to meet the needs of the situation he addressed", that such a discussion by Yoshida does not in any way limit a modification for adding a second or third letter. For instance if there are only a few stations in the database then entering only one letter may be sufficient to sort the database so that the user could easily find the desired station. But if the database holds hundreds of channels, then it would clearly be desirable to sort the database using multiple letters.

In response to applicant's argument on page 14, that the combination references is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed

invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, examiner asserts that since Siitonen is a computer and is directed to searching names in a computerized database, it is analogous art. However, even if it could be construed that the PDA is not related to searching station names in a TV environment per se, the reference is directed to searching web site names in a PC environment, which is a feature recited in the claims. Furthermore the feature of refining a database search as taught by Siitonen, clearly is reasonably pertinent to the particular problem with which the applicant was concerned, and thus meets the test as presented in the above citation.

On page 14, appellant also argues with respect to the claims “channel macros”. However, examiner points out that the claimed channel macros read on the user inputting the station names into the input device. It is pointed out that appellant’s specification on page 12, explains that, “The macro could be a station/network abbreviation (ex. NBC, CBS, ABC). These are called channel macros. Thus the user could input a channel macro into the keyboard to change the channel”. The Gateway 2000 teaches that the user can search stations according to station signs, whereas Yoshida more specifically discusses inputting a character that represents the station, which reads on the claimed channel macro.

Appellant also argues on page 17 that because during the process of the case, examiner relied upon different references to teach the claimed feature of the “second character entry”, namely Youman & Gavron, evidences a mindset of impermissible *ex post facto* analysis by the examiner. It appears that appellant is asserting that the present rejection is somehow tainted by

previous rejections. Examiner disagrees with this reasoning and points that each grounds of rejection in each Office Action stands on its own and is not dependent upon any other rejection made in any other Office Action. Furthermore examiner points out that the appellant made numerous amendments to the claims during this process, and the different references relied upon by examiner was used in order to meet claims in their current status. For instance, examiner relied upon Youman, in part, in the Office Action mailed 7/31/02, whereas in the responding amendment mailed 11/22/02, appellant substantially amended claims 8 & 20. Likewise, in the Office Action mailed 2/19/03, examiner relied upon Gavron in part, whereas in the responding amendment mailed 5/19/03, appellant again amended claim 8. Examiner supplied the Siitonens reference after this amendment, in the Office Action mailed 11/21/03.

With respect to appellant's argument on page 17-18, regarding claim 24 that the claimed feature of, "placing the PC/TV in a user selectable TV mode providing a full screen display and no user accessible PC functionality or in a computer mode providing PC functionality and with a video window in said display being in focus", the Gateway 2000 reference clearly meets the claimed features. Full-screen TV mode as disclosed by Gateway 2000 reads on the claimed subject matter and a resizable window that can be moved around a desktop reads on "computer mode with a video window in said display being in focus". Therefore, notwithstanding appellant's remark regarding the marketing nature of the Gateway 2000 publication, examiner asserts that the claimed subject matter is taught by the reference.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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